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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/515,793	02/29/2000	Damon V. Danieli	MICR0183	1134

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EXAMINER

ZIA, SYED

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 08/27/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/515,793

Applicant(s)

DANIELI ET AL.

Examiner

Syed Zia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This is in response to amendment filed on June 09, 2003 (Paper No. 6). Applicant originally filed Claims 1-38. Applicant amended Claim 35. Applicant left unchanged Claims 1-34, and 36-38. The amendment filed have been entered and made of record. Presently pending claims are 1-38.

Response to Arguments

Applicant's arguments filed on June 09, 2003 (Paper No. 6) have been fully considered but they are not persuasive because of the following reasons:

Regarding Claims 1-38 applicants argued that the cited admitted prior art (APA) [James et al.] (U. S. patent 6,179,713) does not teach, "*e electronic invitation which was sent automatically to selectively join the multiplayer, enabling a player who was invited by the host player to be participant in a chat session, launching an instance of a multiplayer online game for each person, chat session is conducted by using voice, player forwarding network address, enabling host player to select players from a list, computer readable medium, providing the headset, and obtaining player contact list from an online messaging service*".

This is not found persuasive. APA teaches system and method for player using personal computer with memory stored, turn-based computer game is accessible by networked addressed server can enter moves separated by turn processing time periods. Current game state information, which are game server processed moves from previous turns are stored in first

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memory location. Future potential moves are recorded and stored in separate second memory location during turn time period for processing during next processing time period. APA's game server processing is operatively associated with second memory location to access future move information during turn time period allowing player modification of one future potential move. First memory location is associated with separate database from game related information, where message server communication processing is provided between players during turn processing time periods. Players do not have to seek each other out to initiate a game. Centralized server resources can be added to accommodate increasing numbers of players. Server can update the current state of the game to all players according to their note format, e.g. TCP/IP protocol and HTTP interpretation by the server according to respective web browser, e.g. Netscape Navigator or Microsoft Internet Explorer. Thus only the basic input/output functions of the web browser are needed to play online service multi player network games, e.g. 3D first-person action, adventure and interactive fiction, education, fighting, strategy, arcade action, simulation, sports and war games (col.3 line 43 to col. 6 line 65).

As a result, APA does implement and teaches a system and method for players to host and join new instances of multiplayer online electronic games.

Applicants clearly have failed to explicitly identify specific claim limitations, which would define a patentable distinction over prior arts.

The examiner is not trying to teach the invention but is merely trying to interpret the claim language in its broadest and reasonable meaning. The examiner will not interpret to read narrowly the claim language to read exactly from the specification, but will interpret the claim language in the broadest reasonable interpretation in view of the specification. Therefore, the

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examiner asserts that APA does teach or suggest the subject matter broadly recited in independent and dependent claims. Accordingly, rejections for Claims 1-38 are respectfully maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-38 are rejected under 35 U.S.C. 102(e) as being anticipated by James et al., U. S. Patent 6,179,713.

2. Regarding Claim 1 James teaches and describes method for enabling a host player to select one or more other participants to join in playing a multiplayer online electronic game, comprising the steps of:

- enabling the host player to create a list of contacts comprising one or more other persons who may be interested in participating in playing the multiplayer online electronic game, enabling the host player to select one or more of the other persons from among the list of contacts to participate in playing the multiplayer online electronic game (col.14 line 35 to line 62);

- automatically sending an electronic invitation to each of the one or more other persons selected by the host player, to join in playing the multiplayer online electronic game, and enabling each of the one or more other persons who receive the electronic invitation that was automatically sent, to selectively join the multiplayer online electronic game as a participant (col.4 line 64 to col.5 line 21).

3. Regarding Claim 14 James teaches and describes method for enabling a host player to select one or more other players to participate in a multiplayer online electronic game played using a plurality of electronic devices linked in communication over a communications network, each of said plurality of electronic devices being operated by a different player, the method comprising the steps of:

- enabling the host player to initiate a chat session (col.13 line 2 to line 8);
- enabling the host player to invite one or more other players to join the chat session, and enabling any of the players who were invited by the host, to be a participant in the chat session (col.14 line 47 to col.15 line 14); and
- automatically launching an instance of the multiplayer online electronic game on each electronic device being operated by any player participating in the chat session, said step of

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automatically launching being in response to a game initiating action performed by the host player so that any player participating in the chat session automatically becomes a participant in the multiplayer online electronic game (col.13 line 10 to line 36).

4. Regarding Claim 29 James teaches and describes a method for enabling a host player to select one or more other players to participate in a multiplayer online electronic game played using a plurality of electronic devices linked in communication over a communications network, each of said plurality of electronic devices being operated by a different player, the method comprising the steps of:

- enabling the host player to initiate a voice chat session (col.13 line 2 to line 8);
- enabling the host player to invite one or more other players to join the voice chat session (col.8 line 29 to line 36);
- enabling any of the players who were invited by the host, to be a participant in the voice chat session (col.4 line 65 to col.5 line 21);
- enabling the host player to forward a network address corresponding to an electronic device being operated by the host to any other player participating in the voice chat session (col.8 line 16 to line 44); and
- transmitting a voice chat message from the host player to any other player participating in the voice chat session, said voice chat message identifying a multiplayer online electronic game that the host player will be launching or has already launched on the electronic device operated by the host player so that any other player participating in the voice chat session can selectively launch an instance of the multiplayer online electronic game on the electronic device

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operated by the player, so that any player participating in the chat session who selectively launches the multiplayer online electronic game becomes a participant in the multiplayer online electronic game (col.14 line 47 to col.15 line 14).

5. Regarding Claim 33 James teaches and describes a system for enabling a host player to select one or more other players to participate in playing a multiplayer online electronic game played using a plurality of electronic devices linked in communication over a communications network, each of said plurality of electronic devices being operated by a different player and including:

- a display on which a user interface is implemented (col.8 line 45 to line 59);
- a memory in which a plurality of machine instructions are stored (col.2 line 51 to line 65); and
- a processor coupled to the memory for executing said plurality of machine instructions, said processor implementing a plurality of functions when executing the machine instructions, including (col.1 line 15 to line 25):
 - enabling the host player to initiate a chat session (col.13 line 3 to line 8);
 - enabling the host player to invite one or more other players to join the chat session, and enabling any of the players who were invited by the host, to be a participant in the chat session (col.14 line 45 to col.15 line 14); and
 - automatically launching an instance of the multiplayer online electronic game on each electronic device being operated by any player participating in the chat session, said step of automatically launching being in response to a game initiating action performed

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by the host player so that any player participating in the chat session automatically becomes a participant in the multiplayer online electronic game (col.13 line 10 to line 36).

6. Claims 2, 4, 8, 10, 11, 13, 15, 16, 21, 24, 25, 27, 28, 30, 32, 34, and 35 are rejected applied as above rejecting Claims 1, 14, 29, and 33. Furthermore, James teaches and describes a system and method of computer games that is played over computer network, wherein:

- the step of providing an availability status for each person in the list of contacts so as to enable the host player to identify persons in the list of contacts who are currently available to participate in playing the multiplayer online electronic game (col.3 line 42 to line 65);

- the host player is enabled to build a list of chat contacts through use of an online messaging service, said list of chat contacts automatically being parsed to create the list of contacts (col.3 line 42 to line 65);

- the electronic invitation comprises a verbal message (col.14 line 47 to col.15 line 15);

- the steps of providing a list of multiplayer online electronic games to the host player, and enabling the host player to select the multiplayer online electronic game from said list of multiplayer online electronic games (col.3 line 42 to line 65);

- the steps of: (a) providing a user interface including a first display area on which the list of contacts is displayed and a second display area corresponding to a voice chat session (col.14 line 35 to line 62); and

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(b) enabling the host to select the one or more contracts to invite to join the voice chat session by selecting one or more contacts from among the list of contacts displayed in the first display area and dragging and dropping them onto the second display area (col.8 line 29 to line 36);

- computer readable medium having computer executable instructions for performing the steps recited in Claim 1(col.7 line 60 to col.8 line 28);

- the step of providing a network address of the electronic device the host player is using and operating so as to enable the host player to invite one or more other players to join in playing the multiplayer online electronic game, by referencing said network address (col.14 line 47 to col.15 line 14);

- the host player is a member of an online messaging service that enables the host player to build a player contact list comprising a list of one or more players with whom the host prefers to chat and/or play multiplayer online electronic games, further comprising the steps of:

- (a) displaying the player contact list to the host player (col.14 line 35 to line 62); and

- (b) enabling the host player to select one or more other players to participate in playing the multiplayer online electronic game from the player contact list (col.8 line 29 to line 36);

- the step of sending an electronic invitation to join the chat session to each of the one or more players invited by the host player to join the chat session (col. 4 line 64 to col.5 line 21);

- each player is a member of an online messaging service that enables the player to build a player contact list comprising a list of one or more players with whom the player prefers to chat and/or play multiplayer online computer games, further comprising the step of:

- (a) providing a list of chat sessions that are being hosted by at least one other player contact in a player contact list built by the player (col.14 line 35 to line 62); and

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(b) enabling the player to join a chat session appearing in the list of chat sessions (col.8 line 29 to line 36);

- the step of providing a headset operatively coupled in communication with each of said plurality of electronic devices, each headset comprising at least one sound transducer and a microphone employed by each players to participate in a voice chat session (Fig.5).

- the steps of providing a list of multiplayer online electronic games; and enabling the host player to select the multiplayer online electronic game that will be played (col.9 line 26 to line 41);

- computer readable medium having computer executable instructions for performing the steps recited in Claim 14 (col.7 line 60 to col.8 line 28);

- the host player is a member of an online messaging service that enables the host player to build a player contact list of one or more players with whom the host prefers to chat and/or play multiplayer online computer games, further comprising the steps of:

- (a) providing the player contact list to the host player (col.14 line 35 to line 62); and

- (b) enabling the host player to select one or more players to participate in the multiplayer online electronic game from the player contact list (col.8 line 29 to line 36);

- computer readable medium having computer executable instructions for performing the steps recited in Claim 29(col.7 line 60 to col.8 line 28);

- the host player is a member of an online messaging service that enables the host player to build a player contact list of one or more players with whom the host may desire to play multiplayer online computer games, and wherein execution of the plurality of machine instructions further implements the functions of:

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(a) obtaining the player contact list from the online messaging service, and (b) displaying the player contact list to the host player (col. 14 line 35 to line 62); and

(c) enabling the host player to select one or more players to participate in the multiplayer online electronic game from the player contact list (col.8 line 29 to line 36);

- each electronic device includes: (a) a microphone operatively coupled to the electronic device and which produces audio signals in response to words spoken by a user into the microphone; and (b) at least one sound transducer operatively coupled to the electronic device so as to replicate sounds corresponding to an audio data signal received over the communications network by the electronic device to which said at least one sound transducer is operatively coupled (col.15 line 50 to line 59).

7. Claims 3, 5, 6, 7, 9, 12, 17-19, 22, 26, 31, and 36 are rejected applied as above rejecting Claims 2, 4, 8, 11, 16, 21, 25, 30, and 35. Furthermore, James describes system and method of on-line messaging to facilitate users to select participants, wherein:

- the step of enabling each person in the list of contacts to select an availability status indicating the person's availability for participating in playing a multiplayer online electronic game (col.3 line 42 to col.4 line 34);

- at least one person in the list of contacts is not currently logged into the online messaging service and has been invited to join the multiplayer online electronic game, further comprising the step of automatically forwarding the electronic invitation to join the multiplayer online electronic game to said at least one person when said at least one person logs into the online messaging service (col.8 line 36 to col.9 line 50);

- selection of game participants and voice chat communications before and during game play is facilitated by a gaming utility that runs on an electronic device operated by each game participant and at least one person in the list of contacts has been invited to join the multiplayer online electronic game and has not started an instance of the gaming utility on the electronic device(s) operated by said at least one person, further comprising the step of automatically forwarding the electronic invitation to join the multiplayer online electronic game to said at least one person when said at least one person launches an instance of the gaming utility on the electronic device(s) operated by said at least one person(col.8 line 36 to col.9 line 50);

- the step of providing an availability status for each person in the list of contacts so as to enable the host player to identify persons in the list of contacts who are currently available for playing the multiplayer online electronic game, said availability status being determined by the online messaging service (col.3 line 42 to col.4 line 34);

- the step of enabling the electronic invitation to be accepted by a person invited to join the game through a verbal response spoken by said person (col. 14 line 47 to col.15 line 15);

- a plurality of contacts can be selected and dragged and dropped onto the second display area at one time (col. 19 line 26 to line 50);

- the step of providing an availability status for each player in the player contact list (col.3 line 42 to col.4 line 34);

- the step of enabling each player to select an availability status indicating the player's availability to join a chat session (col.13 line 1 to col.14 line 37);

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- the steps of: (a) providing a user interface including a first display area on which the list of contacts is displayed and a second display area corresponding to a voice chat session (col.14 line 35 to line 62); and

- (b) enabling the host to select the one or more contracts to invite to join the voice chat session by selecting one or more contacts from among the list of contacts displayed in the first display area and dragging and dropping them onto the second display area (col.8 line 29 to line 36);

- the electronic invitation includes an audible announcement apprising any player receiving the electronic invitation that the host player has invited the player to join the chat session (col.14 line 47 to col.15 line 15)

- the step of enabling a player to transmit voice chat data to all of the other players who have joined the voice chat session (Fig.5).

- the step of providing an availability status for each player in the player contact list (col.13 line 1 to col.14 line 37);

- execution of the plurality of machine instructions further implements the function of sending an electronic invitation to join the chat session to a player invited by the host player to join the chat session (col.4 line 64 to line 52, and col.7 line 60 to col.8 line 28).

8. Claims 20, 23, and 37-38 are rejected applied as above rejecting Claims 19, 22, and 35
Furthermore, James teaches and describes on-line game playing mechanism, wherein:

- a plurality of contacts can be selected and dragged and dropped onto the second display area at one time (col.9 line 26 to line 50);

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- the step of enabling the electronic invitation to join the chat session to be accepted by a recipient through a verbal response spoken by the recipient, whereupon said recipient becomes a participant in the chat session (col.14 line 47 to col.15 line 15);

- the electronic invitation causes an audible announcement to be produced with said at least one sound transducer apprising each recipient of the electronic invitation that the host player has invited the recipient to join the chat session (col.14 line 62 to col.15 line 14);

- execution of the plurality of machine instructions further implements the function of enabling the electronic invitation to be accepted by a recipient through use of a verbal response spoken into the microphone by the recipient (col.7 line 60 to col.8 line 28, and col.14 line 47 to col.15 line 15).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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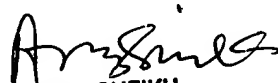
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 703-305-3881. The examiner can normally be reached on Monday - Friday 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

SZ


AYAZ SHEIKH
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